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EXAMINER
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JOO, JOSHUA

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/034,372	MASAO ET AL.	
	Examiner	Art Unit	
	Joshua Joo	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment filed 5/17/2006***

1. Claims 7-12 are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Regarding claims 7, 9, 11, and 12, the newly added limitation of (Claims 7 and 11) "without receiving from the recipient an instruction for the transmission of the HTML data to the recipient" and (Claims 9 and 12) "without receiving, from a user of the receiving Internet facsimile apparatus, an instruction for the transmission of the e-mail data to the receiving Internet facsimile apparatus" are a negative limitation used to overcome the rejections and therefore fails to comply with the written description requirement. Regarding negative limitations, the MPEP states:

**2173.05(i) Negative Limitations**

"...Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. ... The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

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5. Specifically for claims 7 and 11, regarding the transmission of HTML data to the recipient, the specification of the instant application discloses:

- i) Page 7, paragraph 0032, "when the ADPT 100 is connected to the IFAX of the sending side, the HTML document data that is received from the later described HTML processor 405, is transmitted to the groupware network 103 via the first LAN I/F 203, according to the HTTP protocol."
- ii) Page 11, paragraph 0054, "Then, the HTML communicator 404 receives the HTML document data that is converted from the e-mail data by the HTML processor 405, and transmits the converted HTML document data to the ADPT 100B (ST 607)."
- iii) Page 13, paragraph 0065, "Parallel to the above preparatory steps for the e-mail, the HTML communicator 404 at the ADPT 100B receives the HTML document data transmitted from ADPTA 100A at ST 607 (ST61).

6. In, Page 10, paragraphs 0045-0048, the specification also describes the transmission of HTML data, in which the ADPT 100A and ADPT 100B exchange a series of messages prior to establish a connection for transmission. Therefore, in addition to the quoted sections (i), (ii), and (iii), the specification does not explicitly disclose the limitation that data is transmitted "without receiving from the recipient an instruction for the transmission of the HTML data to the recipient". The specification describes only of HTML data being transmitted to the recipient after a connection is established.

7. As per claims 9 and 12, regarding the transmission of HTML data to the receiving Internet facsimile apparatus, the specification of the instant application discloses:

- iv) Page 6, paragraph 0030, "the e-mail communicator 403 retrieves e-mail data that is stored in RAM 202, and transmits the e-mail data to the IFAX of the receiving side via the second LAN I/F 204, according to the SMTP protocol."
- v) Page 13, paragraph 0067, "Upon receiving "354" as a response signal from the IFAX 101B, the e-mail communicator 403 retrieves the e-mail data that is received from ADPT 100A and stored in RAM 202, and transmits the data to the IFAX 101B (ST614).

8. From quoted sections (iv) and (v), the specification describes that the IFAX and the ADPT exchange messages prior to transmitting the email data. However, the specification does

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not explicitly disclose the limitation that e-mail data is transmitted "without receiving, from a user of the receiving Internet facsimile apparatus, an instruction for the transmission of the e-mail data to the receiving Internet facsimile apparatus."

9. Furthermore regarding claims 7 and 11, the limitation of "without receiving from the recipient an instruction for the transmission of the HTML data to the recipient" further lacks support from instant application. Applicant specification discloses,

- vi) Page 9, paragraph 0042, "upon receiving a command signal (SYN ACK) to acknowledge the synchronization, which is transmitted from the ADPT 100B in response to the command signal (SYN)..."
- vii) Page 9, paragraph 0046, "the ADPT 100B output an error signal including a certification request as a response signal, to the ADPT 100A."
- viii) Page 10, "data including the transmission form ("transmission form data") is output toward the ADPT 100A..."

10. From (vi) to (viii), Applicant's specification discloses multiple steps of receiving from the recipient, instructions for the transmission of data to the recipient, which is therefore in contradiction to the limitation of "without receiving from the recipient an instruction for transmission of the HTML data to the recipient"

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, US Patent #6,836,792 (Chen hereinafter), in view of Toyoda et al, US Patent #5,881,233

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(Toyota hereinafter), Beer et al, US Patent #5,864,676 (Beer hereinafter), and Higley, US Patent #6,065,048 (Higley hereinafter).

13. As per claims 7 and 11, Chen teaches substantially the invention as claimed including the method and apparatus for converting and transmitting messages across a network, Chen's teachings comprising:

a first communicator configured to be connected to a network, the first communicator being a component of the communication control apparatus (Col 2, lines 27-30. HTML accessed by the recipient. First communicator is inherent since the system is able transmit the HTML to the recipient.);

a second communicator configured to be connected to an apparatus, the apparatus transmitting, to a recipient via the communication control apparatus, an e-mail, the second communicator being a component of the communication control apparatus (Col 2, lines 1-2. Receives email from sender. Second communicator is inherent since the system is able to receive email.); and

a controller configured to:

receive, from the apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol (Col 1, lines 59-61. Composed email message includes email address. Col 2, lines 1-2. Email system receives email message. Col 2, line 10. SMTP.); receive, from the apparatus via the second communicator, e-mail data directed to the recipient according to the SMTP protocol (Col 1, lines 59-61. Composed email message includes email address. Col 2, lines 1-2. Email system receives email message. Col 2, line 10. SMTP.);

convert the received e-mail data into HTML data (Col 2, lines 30-35. Convert email message to HTML.); and

transmit to the recipient, via the first communicator, the HTML data according to a HTTP protocol (Col 2, lines 30-36. Send message to front end. Front end is implemented in a web browser.).

14. Chen teaches substantial features of claims 7 and 11 including that email messages include the email address. However, Chen does not teach of the apparatus being an Internet facsimile apparatus transmitted email to which scanned image data is attached; converting the email address of the recipient into URL data and transmitting the HTML data based on the URL data; and transmitting the HTML data without receiving from the recipient an instruction for the transmission of the HTML data to the recipient, based on the URL data.

15. Toyoda teaches of a facsimile apparatus capable of scanning image data and transmitting the image data via email (Col 29, lines 19-33).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Chen with the teachings of Toyoda because the teachings of Toyoda for a facsimile apparatus to scan an image and to transmit an email would improve the capability of Chen's system by allowing more than one type of apparatus to transmit email messages and receive HTML converted messages.

17. Beer teaches the concept of converting an email address into URL data (Col 4, lines 10-30) to allow users access data (Col 3, lines 27-31).

18. Chen and Beer do not specifically teach of transmitting HTML based on URL data. However, Beer does teach of accessing URL data to obtain private data. Therefore, it is obvious to one of ordinary skill in the art that the private data transmitted to the user by the URL data may be HTML data and that HTML data may be addressed by URL data. Furthermore,

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the teachings of Beer to convert the email address into URL data and to access HTML data based on the URL would improve the system of Chen and Toyoda by allowing the user to access information with a web browser from public networks.

19. Higley teaches a similar system for converting email to HTML data (Col 6, lines 53-57), wherein the HTML data can be transmitted to the user in the same manner as receiving email (Col 7, lines 28-30).

20. Higley does not explicitly teach of transmitting without intervention by the user. However, Higley teaches of transmitting HTML data in the same manner as transmitting email, and one of ordinary skill would know that email is sent without user intervention. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen, Toyota, Beer, and Higley because the teachings of Higley to transmit HTML data without intervention would improve the user friendliness of the system of Chen, Toyota, and Beer by automatically transmitting HTML data, wherein the user may receive HTML data without having to access the HTML data from the server.

21. As per claim 8, Chen does not teach the communication control apparatus according to claim 7, wherein the controller converts the e-mail address of the recipient into the URL data by converting an @ mark in the e-mail address of the recipient into a dot and adding HTTP:// at the beginning of the e-mail address of the recipient.

22. Beer teaches of converting an email address to an URL, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).



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23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen, Toyota, Beer, and Higley because the teachings of Beer to convert an email address, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address would improve the teachings of Chen by allowing the user to access converted email by URL and by specifying the process of the conversion from email based protocol to a web based protocol. Beer's teachings also would allow users to access their converted email information on a public computer system with a web browser.

24. Claims 9, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Britton, US Publication #2002/0177757 (Britton hereinafter), in view of Toyoda and Beer.

25. As per claims 9 and 12, Britton teaches substantially the invention as claimed including the method and apparatus for converting and transmitting messages across a network, Britton's teachings comprising:

a first communicator configured to be connected to a network (Paragraph 0053; 0063. Receives HTML data. First communicator is inherent since the controller is able to receive HTML data from the web.);

a second communicator configured to be connected to a receiving apparatus, the receiving apparatus receiving, from a transmitter via the communication control apparatus, an e-mail (Paragraph 0053; 0063. Transmits email to the device. Second communicator is inherent since the controller is able to transmit to the device.); and

a controller configured to:

receive, from the transmitter via the first communicator, HTML data according to the HTTP protocol (Paragraph 0053; 0063. Receive HTML data.);

convert the received HTML data into e-mail data (Paragraph 0053; 0063. Convert HTML into email data.); and

transmit to the receiving apparatus, via the second communicator, the e-mail data without receiving, from a user of the receiving Internet facsimile apparatus, an instruction for the transmission of the e-mail data to the receiving Internet facsimile apparatus, based on the e-mail address according to a SMTP protocol (Paragraph 0053; 0063. Transmits email message to the device. Controller forwards email data to the user.).

26. Britton teaches substantial features of claims 9 and 12 including users accessing web sites to transmit HTML data. However, Britton does not teach that the device is specifically a facsimile apparatus and receiving an email to which the image data is attached and printing the image data to the received e-mail; and receiving, from the transmitter via the first communicator, URL data according to a HTTP protocol; and convert the received URL data into an e-mail address of the receiving Internet facsimile apparatus.

27. Toyoda teaches of facsimile apparatus that receives email, wherein a printer is integrated into the facsimile apparatus (Col 29, lines 19-25) that allows for printing image data (Col 32, lines 66-67).

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Britton with the teachings of Toyota because the teachings of Toyota for a facsimile apparatus to receive email data and to print the image data would improve the system of Britton by allowing more than one type of apparatus to receive email data.

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29. Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats (Col 4, lines 10-30).

30. Even though Beer does not specifically teach of converting URL data to an e-mail address, Beer does teach of converting an email address to a URL. It would have been obvious to one of ordinary skill in the art to use Beer's teachings to create a method of converting an URL into an email address by reversing Beer's process since senders in Britton's system transmit information through web pages. To convert URL into email address would improve the teachings of Britton by allowing the users, e.g. patents, to transmit personal web pages containing HTML data to the receivers, and allowing receivers to receive information based on the user's URL.

31. As per claim 10, Britton does not teach the communication control apparatus according to claim 9, wherein the controller converts the URL data to the e-mail address of the receiving Internet facsimile apparatus by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark.

32. Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).

33. Even though Beer does not specifically teach of converting URL data to an e-mail address by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark, Beer does teach of converting an email address to an URL by adding HTTP:// to the email address and converting the "@" into a dot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to user Beer's teachings to create a

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method to convert URL into an email address by reversing Beer's process. To convert an URL into an email address by deleting HTTP:// in the URL and converting the dot into an "@" would improve the teachings of Britton by specifying the process of conversion to allow the email data to be transmitted through the SMTP, and the conversion would allow apparatuses with SMTP based applications to receive the email.

### ***Response to Arguments***

34. Applicant's arguments filed 5/17/2006 have been fully considered but they are not persuasive. Applicant argued that:

35. (1) The sequence chart of Fig. 5 and Paragraphs 0042-0048 and 0054 shows "without receiving from the recipient (ADPT 100B) an instruction for the transmission of the HTML data to the recipient (ADPT 100B)..." The sequence chart of Fig. 5 and Paragraphs 0063-0064, 0067, and 0074 shows "without receiving, from a user of the receiving Internet facsimile apparatus 101B, an instruction for the transmission of the e-mail data..."

In response, MPEP states 2173.05(i) Negative Limitations

**"...Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. ... The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

In the citations provided by the Applicant, there is no explicit disclosure of any negative limitation. Applicant's original disclosure and the above citations provided by the Applicant disclose of transmitting HTML data and e-mail data between a sender and a receiver. However as stated by the MPEP, just because Applicant's disclosure does not disclose the step of a user

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transmitting instructions for the HTML data or the e-mail, this does not provide a basis for exclusion.

36. (2) Chen, Beer, and Toyoda do not disclose a controller which converts the e-mail address of the recipient into URL data and a controller that transmits HTML data to the recipient, based on URL data.

In response, as presented in the previous rejection, Chen does not teach of converting the email address into URL data, and Chen and Beer do not explicitly teach of transmitting HTML data *based on* URL data. Chen does teach of transmitting HTML data (Col 2, lines 30-36), and Beer teaches the steps of converting an email address to a URL (Col 4, lines 10-30), wherein the converted URL provides access to private data (Col 3, lines 26-34). It would have been obvious to one of ordinary skill in the art to combine the teachings of Chen and Beer so that the data accessed by the URL in Beer's teachings may be the HTML data taught by Chen, which would then teach the limitation of transmitting HTML data based on URL data. Doing so would allow users to access private information from public networks with a browser (Beer, Col 3, lines 26-34).

Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of Chen and Beer would improve the system of Chen by allowing users to access HTML data with a browser on public networks (Beer, Col 3, lines 26-34).

37. (3) In applying Highley, Examiner's assertion that one of ordinary skill knows that email is sent without user intervention is incorrect. Applicants submit that a user must take an affirmative action to load an email program and request the checking for e-mail.

In response, Applicant's argument that a user must load an email program, which constitutes as user intervention by the Applicant, is moot because the receiver in Applicant's disclosure must load a program as well to receive and access data. Furthermore, it is well known in the art that email may be received without user intervention.

For example, Rasor US Patent #5,714,943, Hasbe US Patent #5,987,609, Van Dusen US Patent #6,175,823, Angotti et al US Patent #6,182,059, Bereiter US Patent #6,185,606, Reilly US Patent #6,427,164, Mayle et al US Patent #6,542,936, Tsuei US Patent #6,654,779, Dutta US Patent #6,681,246, and Hachiya et al US Patent #6,760,751 all disclose of transmitting by the sender an email to the recipient.

38. (4) Britton and Toyoda does not disclose a controller which receives, from the transmitter via the first communicator, URL data according to a HTTP protocol, and a controller which converts the received URL data into an e-mail address of the receiving Internet facsimile apparatus.

Firstly, Toyoda was provided to teach that a facsimile apparatus receiving email is taught in the art (Col 29, lines 19-25). Secondly, Britton and Toyoda do not teach of receiving URL data and converting the URL data into e-mail address. However, Britton teaches of converting HTML data into email message and transmitting the email, and Beer teaches the steps of converting email address to URL (Col 4, lines 10-30). It would have been obvious to one of

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ordinary skill to reverse the steps of Beer to convert URL into email address and combine the teachings of Britton, Toyoda, and Beer because the combined teachings would allow users to transmit web pages and identifiers of the HTML data, and providing an identifier, i.e. email address, to route the email message to the device.

39. (5) Examiner has not set forth a proper motivation for combining Britton and Beer et al so as to receive, from the transmitter via the first communicator, URL data according to a HTTP protocol, and to convert the received URL data into an e-mail address of the receiving Internet facsimile apparatus.

In response, Britton teaches, "the controller 800 may convert a Hypertext Markup Language (HTML) indication received via the Web site into an electronic mail message and transmit the electronic mail message to the medical care provider device 120" (Paragraph 0053). However, Britton does not specify how the electronic mail message is routed or any information identifying the converted HTML data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Britton and Beer because the combined teachings would specify and provide an identifier, i.e. email address, for routing the email message to the correct destination.

### ***Conclusion***

40. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned 571-273-8300.

43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 22, 2006  
JJ

  
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